

REMARKS/ARGUMENTS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

New claims 12-16 are provided, which can be seen as clearly derived from claim 11. Applicants do not believe that new claims 12-16 introduce any new matter. An early notice to that effect is earnestly solicited.

On pages 2-3 of the Office Action, the Examiner provides a preferred arrangement of the specification and suggests Applicants' use thereof. In response, Applicants again prefer not to amend the specification to include the suggested headings and subheadings.

Claim 9 was objected to because of certain informalities. In response, Applicants have made editorial changes to claim 9 to specify in the claimed embodiment that the solvent-free pressure-sensitive polyacrylate dispersion mentioned is the same solvent-free pressure-sensitive polyacrylate dispersion recited in claim 1.

Claims 1-11 were rejected under 35 USC § 103(a) as being obvious over Nakagawa et al. ("Nakagawa"), US 2001/0031355, in view of Aritake, US 4,513,028. In response, Applicants respectfully submit that the cited combination of references fails to make out a *prima facie* case of the obviousness of the instant claims. Even assuming, for the sake of argument, that a *prima facie* case of obviousness were made out, Applicants respectfully submit that such *prima facie* case is rebutted by the data in the instant specification. In either case, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

According to the Examiner:

“It would have been obvious to one skilled in the art to use the adhesive layer as taught by Aritake for the adhesive layer of Nakagawa et al. since it is taught by Nakagawa et al. that any adhesive ([0057]) can be used as the foil and the adhesive taught by Aritake can be easily applied to a substrate and provides an adequate adhesion property (Aritake, col. 6, lines 46-53).”

However, the Examiner provides no reason why persons skilled in the art should choose Aritake’s adhesive from all the known adhesive systems as the system of choice for modifying Nakagawa’s system. The Examiner has not pointed to a single advantage that Aritake’s adhesive would have been expected to have over Nakagawa’s adhesive that would arguably have provided persons skilled in the art with adequate motivation to make the substitution the Examiner proposes. In the absence of such motivation, Applicants respectfully submit that the combination of Nakagawa and Aritake fails to make out a *prima facie* case of the obviousness of the instant claims.

As reaffirmed by the Court in *In re Regel et al.*, 188 USPQ 136, 139, footnote 5 (CCPA 1975):

“The mere fact that it is *possible* to find two isolated disclosures which might be combined in such a way to produce a new compound does not necessarily render such production obvious unless the art also contains something to suggest the *desirability* of the proposed combination (emphasis added).”

The Examiner has not pointed to anything in either Nakagawa or Aritake or in their

combination to suggest the desirability of the combining their respective teachings. Applicants respectfully submit that the existence of Aritake's adhesive, in and of itself, does not provide evidence of its desired use in Nakagawa's system and, therefore, of the existence of adequate motivation to make the proposed combination. In the absence of a plausible reason why persons skilled in the art would have found it desirable to employ Aritake's adhesive in Nakagawa's system, Applicants respectfully submit that the Examiner has not made out a *prima facie* case of obviousness.

Second, even if such a combination were properly made—which Applicants do not concede—there is nothing in the cited combination of references that would have led persons skilled in the art to expect the unexpectedly improved combination of properties as evidenced by the data in the instant specification on pages 34-39.

As described in numbered paragraph [0067] of the published application, US 2007/0074894, a main objective of the present invention was to provide a wrapping foil characterized by the absence of halogens and volatile plasticizers in tandem with high flame retardancy and flexibility. However, there are other stated objectives of the present invention, among them to provide a wrapping foil compatible with polyolefin-based cable sheathing, as evidenced by the fact that neither the wrapping foil nor the cable insulation becomes brittle (see [0069]); and to provide a wrapping foil characterized by good hand-tearability (see [0010] and [0119]).

According to the Examiner, Nakagawa teaches “that *any* adhesive ([0057]) can be used with the foil.” The Examiner thereby implicitly concedes that the nature of the adhesive is unimportant and does not contribute significantly to results.

However, a summary of some of the pertinent results from the table on page 39 of the specification reveals quite surprisingly, given Nakagawa, that adhesives based on polyacrylate dispersions provide a distinct advantage:

| Property | Example 1 | Example 2 | Example 3 | Example 4 |
|---|-------------|----------------|-------------|-------------|
| Type of Acrylate Adhesive | Dispersion | Hotmelt | Solution | Dispersion |
| Compatible with PE and PP cables after 3000 hrs @ 105°C | Not Brittle | Not Brittle | Not Brittle | Not Brittle |
| Compatible with PE and PP cables after 2000 hrs @ 125°C | Not Brittle | Brittle | Not Brittle | Not Brittle |
| Hand Tearability | ++ | ++ | + | ++ |

Examples 1-4 each involved the use of a wrapping foil based on polymer A (see the table on page 30); and an acrylate adhesive as indicated. Surprisingly, given Nakagawa, only Examples 1 and 4, which utilized acrylate adhesive *dispersions*, gave a combination of both superior compatibility with polyolefin-based cable sheathing, as evidenced by the fact that neither the wrapping foil nor the cable insulation became brittle, and superior hand tearability. Example 2, which is characterized by the use of an acrylate adhesive *hotmelt* gave good hand tearability, but proved inferior in terms of its compatibility with PE and PP cables after 2000 hrs @ 125°C inasmuch as the wrapping foil became brittle. Example 3, which is characterized by

the use of an acrylate adhesive *solution*, like Nakagawa, proved compatible, but was inferior in terms of its hand tearability.

As noted above, the Examiner does not point to anything in Nakagawa or in Aritake or in their combination that would have suggested that acrylate adhesive dispersions should be superior in any way to acrylate adhesive solutions, particularly in regards to combatibility with PE and PP cables and hand tearability. Consequently, the data in the instant specification, as discussed above, must be regarded as surprising and unexpected and, therefore, also as objective evidence of nonobviousness. *See, for example, In re Chupp*, 2 USPQ2d 1437, 1439 (Fed. Cir. 1987) (“Evidence that a compound is unexpectedly superior in one of a spectrum of common properties, as here, can be enough to rebut a *prima facie* case of obviousness.”) Further, although these data are not in declaration form, consistent with the rule that *all* evidence of nonobviousness must be considered when assessing patentability, the Examiner must consider data in the specification in determining whether the claimed invention provides unexpected results. *In re Soni*, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995).

Summarizing the foregoing, Applicants respectfully submit that the combination of Nakagawa and Aritake does not make out a *prima facie* case of obviousness, but even assuming, merely for the sake of argument, that a *prima facie* case of obviousness were made out, such *prima facie* case is rebutted by the data in the instant specification showing the unexpectedly superior results attendant the use of an acrylate adhesive dispersion, as instantly claimed.

In view of the foregoing, Applicants respectfully submit that the Examiner should reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,
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